

REPLY BRIEF

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Title: Interface and Method Adapted for Capturing Subjective Preferences of Program Users

Page 1

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S/N 09/945,099**PATENT****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant:	Timothy Orr Knight	Examiner: Peng Ke
Serial No.:	09/945,099	Group Art Unit: 2174
Filed:	August 31, 2001	Docket No.: 0006-003004
Title:	INTERFACE AND METHOD ADAPTED FOR CAPTURING SUBJECTIVE PREFERENCES OF PROGRAM USERS	

REPLY BRIEF

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This Reply Brief is submitted in response to the Examiner's Answer mailed January 10, 2008. For the sake of brevity herein, the Appeal Brief filed on July 26, 2007 is hereby incorporated by reference in its entirety.

I. REAL PARTY IN INTEREST

Maquis Techtrix, LLC is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

To the best knowledge of Appellant, Appellant's legal representative, and Appellant's assignee, there are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on a decision by the Board of Patent Appeals and Interferences ("the Board") in the pending appeal.

III. STATUS OF CLAIMS

Claims 42-52 and 91-145 are pending in this appeal, in which claims 1-41 and 53-90 have earlier been canceled. No claim is allowed. This appeal is therefore taken from the final rejection of claims 42-52 and 91-145 on August 23, 2006.

IV. STATUS OF AMENDMENTS

No amendment to the claims has been filed subsequent to the final rejection of claims 42-52 and 91-145 on August 23, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The Status of the Claimed Subject Matter is incorporated by reference from the Appeal Brief filed on July 26, 2007 (section V, pp. 3-8).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The Grounds of Rejection to be Reviewed on Appeal are incorporated by reference from the Appeal Brief filed on July 26, 2007 (section VI, p. 8).

VII. ARGUMENT

The "Arguments" section of the Appeal Brief filed on July 26, 2007 (section VII, pp. 9-48) is incorporated by reference herein in response to the Examiner's "Grounds of Rejection" (Examiner's Answer mailed January 10, 2008, p. 3, l. 4 - p. 19, l. 18), which appear to be a copy of the claim rejections included in the final Office Action mailed August 22, 2006. Supplementally, in response to the Examiner's "Response to Argument" (Examiner's Answer mailed January 10, 2008, p. 19, l. 19 - p. 23, l. 5), Appellant responds as follows:

A. MANGHIRMALANI ET AL. FAILS TO ANTICIPATE CLAIMS 141- 143.

To anticipate a patent claim, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

1. Independent claim 141 is not anticipated by *Manghirmalani et al.*

Regarding the rejection of independent claim 141 under 35 U.S.C. 102(b) as being anticipated by *Manghirmalani et al.*, Appellant respectfully submits that *Manghirmalani et al.* does not disclose or suggest all of the features recited in claim 141.

For example, claim 141 recites:

“A data picture record derived from data input in the form of a graphical arrangement by a user, the data picture record comprising:
an identifier indicating a particular action and/or a transaction identified by the user as related to the data input;
an identity of a data parameter selected by the user to express the data input and used in the graphical arrangement for the particular action and/or transaction;
and
a weighting factor associated with said data parameter, said weighting factor being derived from a relative placement of said data parameter within the graphical arrangement.”

The Examiner now contends that "the equations are graphical arrangements" (Examiner's Answer mailed January 10, 2008, p. 21, l. 1), in reference to "equations" that the Examiner contends are formulated from "available parameters" allegedly disclosed by *Manghirmalani et al.* However, nowhere does *Manghirmalani et al.* disclose any "equations" appearing as any type of "graphical arrangement." At best, any "equations" disclosed by *Manghirmalani et al.* may be implemented via software, and not displayed as a "graphical arrangement" (as an "equation") to a user. Claim 141 clearly recites (emphasis added) a "data picture record derived from *data input in the form of a graphical arrangement by a user*," and *Manghirmalani et al.* has no disclosure or suggestion that any user inputs any data directly in the form of an "equation" that is a "graphical arrangement."

The Examiner correctly states (Examiner's Answer mailed January 10, 2008, p. 20, ll. 6 - 10), "During patent examination, the pending claims must be 'given >their< broadest reasonable interpretation consistent with the specification'." Appellant respectfully adds that well-settled case law holds that the words of a claim must be read as they would be interpreted by those of

ordinary skill in the art. *In re Baker Hughes Inc.*, 215 F.3d 1297, 55 USPQ2d 1149 (Fed. Cir. 2000); *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); M.P.E.P. 2111.01. “Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach.” *In re Cortright*, 165 F.3d 1353, 1369, 49 USPQ2d 1464, 1465 (Fed. Cir. 1999). Here, one skilled in the art of data processing would clearly recognize that *Manghirmalani et al.* does not disclose these features of claim 141.

Further, Appellant respectfully submits that, unless the patent otherwise provides, a claim term cannot be given a different meaning in the various claims of the same patent. *Georgia Pacific Corp. v. U.S. Gypsum Co.*, Nos. 97-1238,-1244 (Fed. Cir., Nov. 1, 1999); see also *Southwall Tech., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1579, 34 USPQ2d 1673, 1679 (Fed. Cir. 1995) (holding that claim term found in different claims must be interpreted consistently); *Fonar Corp. v. Johnson & Johnson*, 821 F.2d 627, 632, 3 USPQ2d 1109, 1113 (Fed. Cir. 1987.) (holding that a term used in one claim had the same meaning in another claim). Thus, the Examiner cannot improperly equate the MIB Objects/Meters shown in the formula 1202’s scroll box 1203 of *Manghirmalani et al.* with the “data parameter” recited by claim 141, apparently equating the ordering of the MIB Objects/Meters shown in the scroll box 1203 with the “graphical arrangement” recited by claim 141, and further contend that “the equations are graphical arrangements,” when the “equations” are not disclosed anywhere as “graphical arrangements” by *Manghirmalani et al.*

As *Manghirmalani et al.* fails in this regard, in addition to the reasons stated in the Appeal Brief mailed July 26, 2007, the rejection of claim 141 should be reversed.

2. Dependent claims 142 and 143 are not anticipated by *Manghirmalani et al.*

The rejections of dependent claims 142-143 should be reversed for at least the same reasons as independent claim 141, and as the claims are separately patentable on their own merits, as argued in the Response mailed on November 22, 2006 (p. 4, l. 28 – p. 5, l. 4).

For example, claim 142 recites, “wherein a collection of data picture records are grouped for said action and/or transaction.” The Examiner (Office Action dated August 23, 2006, page 3,

lines 5-7) contends that this feature is taught by *Manghirmalani et al.* at col. 7, line 55- col. 8, line 8. The Examiner further contends (Examiner's Answer mailed January 10, 2008, p. 21, ll. 6 - 9) that this portion of *Manghirmalani et al.* "teaches a collection of data picture records that are grouped as claimed because data of selected parameters are gathered to create graphical status indicator as to the health, the load rate, and the error rate of a network."

However, this contention makes no sense within the context of *Manghirmalani et al.*, as this portion of *Manghirmalani et al.* merely mentions that an end-user can vary "the impacts of the utilization, collision rate, and error rate on the overall health score" based on varying weights assigned to each type of network specific data. There is no disclosure or suggestion of any "collection of data picture records" that are "grouped" for any particular "action and/or transaction" as recited by claim 142. To anticipate a patent claim, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, *supra*; *Scripps Clinic & Research Foundation v. Genentech, Inc.*, *supra*. The Examiner has failed to meet this burden with regard to claim 142. Thus, the rejection of claim 142 should be reversed.

By virtue of its dependency on allowable dependent claim 142, dependent claim 143 is allowable for at least the same reasons as claim 142, and is separately patentable on its own merits. Thus, the rejection of claim 143 should also be reversed.

B. CLAIMS 42-45, 48-52, 91-94, 98-101, 105-108, 110, 111, 113-123, 126, 127, 129, 131-134, 136, and 140 ARE NOT RENDERED OBVIOUS BY MANGHIRMALANI ET AL. IN VIEW OF TULI ET AL.

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision always rests upon the Examiner. *In re Mayne*, 104 F.3d 1339, 41 USPQ2d 1451 (Fed. Cir. 1997); *In re Deuel*, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995); *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to provide a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 357 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970).

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

“Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. *See In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) ([R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.)” *KSR Int’l v. Teleflex, Inc.*, No. 04-1350, slip op. at 14 (U.S., April 30, 2007)

Regarding the rejections of independent claims 42, 91, 99, 106, 111, 121, 126, 131, and 136 under 35 U.S.C. 103(a) as being unpatentable over *Manghirmalani et al.* in view of *Tuli et al.*, Appellant respectfully submits that *Manghirmalani et al.* in view of *Tuli et al.* does not disclose or suggest all of the features recited in the above-listed independent claims, nor in their respective dependent claims.

1. Independent claim 42 and dependent claims 43-44 are not rendered obvious by *Manghirmalani et al.* in view of *Tuli et al.*

a. Independent claim 42 is not rendered obvious by *Manghirmalani et al.* in view of *Tuli et al.*

For example, independent claim 42 recites:

“An electronic interface for collecting information for a data picture, the interface comprising:
a data palette providing a set of data parameters available for selection, said set of data parameters including at least some corresponding to predefined statements concerning an action and/or a transaction; and

a data canvas on which a selected set of one or more of said set of data parameters can be displayed and relatively positioned arbitrarily by a user to generate the data picture,

wherein the data picture includes a display of a graphical relative positioning of the selected set of data parameters relative to one another, the graphical relative positioning being configured by the user within the data canvas.”

The Examiner now contends that "the combination would have yielded an interface that allows users to display the available data parameters in Manghirmalani in a graphical representation suggested by Tuli, which is a predictable result that would have been obvious to one of ordinary skill in the art at the time of the invention" (Examiner's Answer mailed January 10, 2008, p. 22, ll. 4-9), in reference to an alleged motivation to combine the references.

Appellant respectfully submits that the dial meters 1301 (and/or 1302 and/or 1303) of FIG. 13 of *Manghirmalani et al.* have nothing to do with any type of “data picture wherein the data picture includes a display of a graphical relative positioning of the selected set of data parameters relative to one another, the graphical relative positioning being configured by the user within the data canvas” as recited by independent claim 42. The Examiner (Office Action dated August 23, 2006, page 4, lines 14-15) correctly acknowledges that “Manghirmalani fails to teach displaying graphically relative positioning of the selected set of parameters,” and relies on *Tuli et al.* to compensate for the deficiencies of *Manghirmalani et al.*

Tuli et al. (per Summary) is directed to a workflow system wherein data input by a user into a spreadsheet is computer generated into a bar chart. The system makes available to a user a graphical display of a priority time management system. There are two windows available to a user. The first window, referred to as the “spreadsheet window,” is primarily used for inputting data. The second window, referred to as the “bar chart window,” is primarily an output window. The output is determined by the criteria of the “spreadsheet window.” The “spreadsheet window” contains a spreadsheet which is divided into multiple rows and columns. The first five columns are labeled as follows: “To-do” item, Priority, Time, Continuous, Deadline. A user inputs into the cells of each column the required data.

The “bar chart” window contains a bar graph. The bar graph consists of a y-axis and an x-axis. The “To-do” items are listed vertically along the y-axis, and the x-axis is time. The x-axis is divided into blocks representing days; each block is further divided into equal segments representing the hours of a typical work day. The bars are plotted according to the variables Priority, Time, and Deadline from the spreadsheet. The bars indicate when a user is to begin and to finish the corresponding task. Tasks which are “discontinuous” are divided into various segments of time, and spread over the days leading up to the deadline. The bars are color coded such that each “To-do” item has a distinct color based upon its priority.

Tuli et al., at col 7, lines 30-48, discusses a user adjusting a priority of a task in the spreadsheet window, which results in a regeneration of the bar graph in the bar chart window, with an adjustment, by the software, of a bar to a different day. The Examiner (Office Action dated August 23, 2006, page 4, lines 16-17) asserts that “displaying graphically relative positioning of the selected set of parameters” as recited by claim 42 is taught by *Tuli et al.* at col. 7, lines 30-48. However, Appellant respectfully submits that re-positioning the bar of *Tuli et al.* had no relevance with the formula of MIB Objects/Meters shown in the formula 1202’s scroll box 1203 of *Manghirmalani et al.*, and thus the Examiner’s assertion would have made no sense technically.

Appellant respectfully submits that *Manghirmalani et al.* had no mention of any priority, and there was no need for any plotting of any graphical presentation of any parameters based on priority for *Manghirmalani et al.*’s apparatus that provided a user with an indication of a computer network’s health. The Examiner fails to explain how such a “graphical presentation of the parameter based on priority” would have been desirable to one skilled in the art, or how it could have or would have been achieved, with regard to *Manghirmalani et al.* The Patent Office must give specific reasons why one of ordinary skill in the art would have been motivated to combine the references. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int’l v. Teleflex, Inc.*, *supra* (citing *In re Kahn*, *supra*). No such reasons have been provided by the Examiner for the present application.

Moreover, adding a plotting of a graphical presentation of parameters based on priority to *Manghirmalani et al.*'s system would have made no sense technically, and would have rendered *Manghirmalani et al.* unsatisfactory for its intended purpose, namely to provide a user with a simple indication of a computer network's health. The dials and graphs of *Manghirmalani et al.* were unsuitable for any modification of any "graphical representation of priority," as urged by the Examiner. If a proposed modification would render the prior art being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Further, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). MPEP § 2143.01

Furthermore, such an addition would only add to the complexity of *Manghirmalani et al.*'s system without adding any benefit. It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 218 USPQ 769 (Fed. Cir. 1983). A prior art reference must be considered in this entirety including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Additionally, an example embodiment of the present application (per Abstract) is directed to selecting and placing data parameters on a data canvas, such that a user can paint a data picture representing his/her subjective motivations, mental impressions, reasons, etc., for engaging in a particular transaction. However, as discussed previously, *Manghirmalani et al.* is directed to providing a user with a simple indication of a computer network's health, and thus, *Manghirmalani et al.* is not analogous prior art. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992); see also *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to

an inventor's attention in considering his problem.""). The system of *Manghirmalani et al.* which was directed to providing a user with a simple indication of a computer network's health would not have commended itself to an inventor's attention in consideration of problems solved by the present application. Thus, the rejection of independent claim 42 must be reversed.

b. Dependent claim 43 is not rendered obvious by *Manghirmalani et al.* in view of *Tuli et al.*

Moreover, dependent claim 43, which depends from claim 42, recites "wherein said selected set of data parameters can be selected and physically moved by such user to a gradient on said data canvas by physically manipulating an electronic pointing device." The Examiner now contends that "Tuli teaches this limitation because it allows the user to drag and drop a data parameter within a bar graph. (see Tuli, col. 4 .lines 60-68) Drag and Drop operations are physical manipulation of the data parameter" (Examiner's Answer mailed January 10, 2008, p. 22, ll. 13-15).

As best understood, the Examiner equates the "data parameters" recited by claims 42 and 43 with the formula shown in the scroll box 1203 and the MIB Objects shown in the scroll box 1205 of *Manghirmalani et al.*'s system. However, the Examiner gives no explanation of how such MIB Objects included in a formula can be "selected and physically moved" by a user to a gradient by selecting and moving bars in a bar graph, as discussed by this portion of *Tuli et al.* Unless the patent otherwise provides, a claim term cannot be given a different meaning in the various claims of the same patent. *Georgia Pacific Corp. v. U.S. Gypsum Co.*, *supra*; see also *Southwall Tech., Inc. v. Cardinal IG Co.*, *supra*; *Fonar Corp. v. Johnson & Johnson*, *supra*.

The Examiner further fails to explain how entering numbers in the spreadsheet cells of *Tuli et al.*, with a resulting change in the bars (apparently accomplished by software), meets "wherein said selected set of data parameters can be selected and physically moved by such user to a gradient on said data canvas by physically manipulating an electronic pointing device" as recited by claim 43. The Patent Office must give specific reasons why one of ordinary skill in the art would have been motivated to combine the references. See, e.g., *In re Kotzab*, *supra*; *In re Rouffet*, *supra*. Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to

support the legal conclusion of obviousness. *KSR Int'l v. Teleflex, Inc.*, *supra* (citing *In re Kahn*, *supra*). No such reasons have been provided by the Examiner for the present application.

Well-settled case law holds that the words of a claim must be read as they would be interpreted by those of ordinary skill in the art. *In re Baker Hughes Inc.*, *supra*; *In re Morris*, *supra*; M.P.E.P. 2111.01. “Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach.” *In re Cortright*, *supra*. Appellant respectfully submits that one of ordinary skill in the art of data processing would understand that “wherein said selected set of data parameters can be selected and physically moved by such user to a gradient on said data canvas by physically manipulating an electronic pointing device” as recited by claim 43 was not met by entering numbers in spreadsheet cells to cause software to change positions of bars in a separate graph.

Thus, the rejection of claim 43 must be reversed.

c. Dependent claim 44 is not rendered obvious by Manghirmalani et al. in view of Tuli et al.

Moreover, dependent claim 44, which depends from claim 42, recites “wherein the data picture is generated using a single data capture screen including said data palette and said data canvas.” The Examiner (Office Action dated August 23, 2006, p. 5, lines 3-5) contends that this feature is taught by *Manghirmalani et al.* at FIG. 13, 1307-1320. However, this cited portion of *Manghirmalani et al.* illustrates icons for selecting a particular type of display, dial meters showing a health, load, and error of the system, and a light bulb icon for selecting a net doctor display. As best understood, the Examiner has previously equated the “data parameters” recited by claims 42 and 43 with the formula shown in the scroll box 1203 and the MIB Objects shown in the scroll box 1205 of *Manghirmalani et al.*’s system. Thus, by the Examiner’s interpretation, and as best understood, the “data palette” and “data canvas” have been equated by the Examiner to structures shown in FIG. 12, which are not shown in FIG. 13. However, FIG. 13 did not show the textual representation of the MIB objects, which the Examiner’s interpretation has equated to the recited “data parameters,” and this interpretation is thus inconsistent with the Examiner’s previous interpretation of the features of independent claim 42. Unless the patent otherwise

provides, a claim term cannot be given a different meaning in the various claims of the same patent. *Georgia Pacific Corp. v. U.S. Gypsum Co.*, *supra*; see also *Southwall Tech., Inc. v. Cardinal IG Co.*, *supra* (holding that claim term found in different claims must be interpreted consistently); *Fonar Corp. v. Johnson & Johnson*, *supra* (holding that a term used in one claim had the same meaning in another claim).

Thus, the rejection of claim 44 must be reversed.

2. Independent claim 91 is not rendered obvious by *Manghirmalani et al.* in view of *Tuli et al.*

Independent claim 91 recites:

“A computer program product comprising:
a signal bearing medium bearing at least one of
 one or more instructions for providing a data palette, said
palette including a set of data parameters available for selection by
a user, such that said set of data parameters includes at least some
corresponding to predefined statements concerning an action
and/or a transaction; and
 one or more instructions for providing a data canvas on
which selected data parameters can be displayed and relatively
positioned arbitrarily by said user to generate a data picture
 wherein the data picture can be based at least in part on a
graphical relative positioning of a selected group of said
predefined statements collected from said user and pertaining to
the user’s mental impressions concerning said action and/or said
transaction, said graphical relative positioning being configured by
the user within the data canvas based on physical positions selected
by the user within the data canvas for said predefined statements
and/or a relative spatial relationship between said predefined
statements within the data canvas concerning said action and/or
said transaction.”

The Examiner (Office Action dated August 23, 2006, page 6, line 6 – page 7, line 5) contends that these features are taught by a combination of *Manghirmalani et al.* at FIG. 12, col. 12, lines 15-46, and *Tuli et al.* at col. 7, lines 30-48. Thus, as best understood, the Examiner equates the recited “data parameters” with the MIB Objects/Meters 1204 shown in the scroll box 1205 of FIG. 12 of *Manghirmalani et al.* However, these portions of *Manghirmalani et al.* merely refer to the MIB objects, wherein the user may view a list of MIB objects, and may

remove an MIB object by clicking on the object in the scroll box 1205 (col. 12, lines 23-26). However, Appellant respectfully submits that there was no mention nor suggestion by *Manghirmalani et al.* of selecting and relatively positioning arbitrarily, any of the MIB objects, by a user, or a graphical relative positioning of the MIB objects being configured by the user within the data canvas based on physical positions selected by the user within the data canvas for said predefined statements and/or a relative spatial relationship between said predefined statements within the data canvas concerning said action and/or said transaction, and thus there was no disclosure or suggestion of “one or more instructions for providing a data canvas on which selected data parameters can be displayed and relatively positioned arbitrarily by said user to generate a data picture” and “wherein the data picture can be based at least in part on a graphical relative positioning of a selected group of said predefined statements collected from said user and pertaining to the user’s mental impressions concerning said action and/or said transaction, said graphical relative positioning being configured by the user within the data canvas based on physical positions selected by the user within the data canvas for said predefined statements and/or a relative spatial relationship between said predefined statements within the data canvas concerning said action and/or said transaction” as recited by independent claim 91.

The Examiner (Office Action dated August 23, 2006, page 6, line 21 – page 7, line 5) correctly acknowledges that “Manghirmalani fails to teach displaying graphically relative positioning of the selected set of parameters,” and relies on *Tuli et al.* to compensate for the deficiencies of *Manghirmalani et al.*, stating:

Tuli teaches graphically relative positioning of the selected set of data parameters. (column 7, lines 30-48)

It would have been obvious to an artisan at the time of the invention to include Tuli’s with method of Manghirmalani in order to provide users with a graphical representation of priority.

Tuli et al. (per Summary) is directed to a workflow system wherein data input by a user into a spreadsheet is computer generated into a bar chart. The system makes available to a user a graphical display of a priority time management system. There are two windows available to a user. The first window, referred to as the “spreadsheet window,” is primarily used for inputting

data. The second window, referred to as the “bar chart window,” is primarily an output window. The output is determined by the criteria of the “spreadsheet window.” The “spreadsheet window” contains a spreadsheet which is divided into multiple rows and columns. The first five columns are labeled as follows: “To-do” item, Priority, Time, Continuous, Deadline. A user inputs into the cells of each column the required data.

The “bar chart” window contains a bar graph. The bar graph consists of a y-axis and an x-axis. The “To-do” items are listed vertically along the y-axis, and the x-axis is time. The x-axis is divided into blocks representing days; each block is further divided into equal segments representing the hours of a typical work day. The bars are plotted according to the variables Priority, Time, and Deadline from the spreadsheet. The bars indicate when a user is to begin and to finish the corresponding task. Tasks which are “discontinuous” are divided into various segments of time, and spread over the days leading up to the deadline. The bars are color coded such that each “To-do” item has a distinct color based upon its priority.

However, the portion of *Tuli et al.* cited by the Examiner (col 7, lines 30-48) refers to a user adjusting priorities of tasks to be completed by different times. The user of the system of *Tuli et al.* adjusts priorities of the tasks by changing values of priorities shown in cells of spreadsheet 24 (FIG. 5c of *Tuli et al.*), and a bar graph 30b is regenerated to reflect the changed values of the spreadsheet cells (FIG. 5d of *Tuli et al.*).

The Examiner (Office Action dated August 23, 2006, page 7, lines 1-2) asserts that “displaying graphically relative positioning of the selected set of parameters” as recited by claim 106 is taught by *Tuli et al.* at col. 7, lines 30-48. However, Appellant respectfully submits that re-positioning the bar of *Tuli et al.* had no relevance with the formula of MIB Objects/Meters shown in the formula 1202’s scroll box 1203 of *Manghirmalani et al.*, and thus the Examiner’s assertion would have made no sense technically.

The Examiner further asserts (Office Action dated August 23, 2006, page 7, lines 3-5), “It would have been obvious to an artisan at the time of the invention to include Tuli’s with method of Manghirmalani in order to provide users with a graphical representation of priority.” However, *Manghirmalani et al.* had no mention of any priority, and there was no need for any graphical representation of priority for *Manghirmalani et al.*’s apparatus that provided a user with an indication of a computer network’s health. The Examiner fails to explain how such a

“graphical representation of priority” would have been desirable to one skilled in the art, or how it could have or would have been achieved, with regard to *Manghirmalani et al.* The Patent Office must give specific reasons why one of ordinary skill in the art would have been motivated to combine the references. *See, e.g., In re Kotzab, supra; In re Rouffet, supra.* Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int’l v. Teleflex, Inc., supra* (citing *In re Kahn, supra*). No such reasons have been provided by the Examiner for the present application.

Generally, obviousness rejections may require some evidence in the prior art of a teaching, motivation, or suggestion to combine and modify the prior art references. *See, e.g., McGinley v. Franklin Sports, Inc., supra; Brown & Williamson Tobacco Corp. v. Philip Morris Inc., supra; In re Dembiczak, supra.* Here, there was no teaching, motivation, or suggestion to combine and modify the either *Manghirmalani et al.* or *Tuli et al.* as urged by the Examiner, nor does the Examiner assert that such a motivation existed in the references.

Moreover, adding a priority representation to *Manghirmalani et al.*’s system would have made no sense technically, and would have rendered *Manghirmalani et al.* unsatisfactory for its intended purpose, namely to provide a user with a simple indication of a computer network’s health. The dials and graphs of *Manghirmalani et al.* were unsuitable for any modification of any “graphical representation of priority,” as urged by the Examiner. If a proposed modification would render the prior art being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon, supra.* Further, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti, supra.* MPEP § 2143.01

Furthermore, such an addition would only have added to the complexity of *Manghirmalani et al.*’s system without adding any benefit. It is improper to combine references where the references teach away from their combination. *In re Grasselli, supra.* A prior art reference must be considered in this entirety including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc., supra.*

Additionally, an example embodiment of the present application (per Abstract) is directed to selecting and placing data parameters on a data canvas, such that a user can paint a data picture representing his/her subjective motivations, mental impressions, reasons, etc., for engaging in a particular transaction. However, *Manghirmalani et al.* was directed to providing a user with a simple indication of a computer network's health, and thus, *Manghirmalani et al.* was not analogous prior art. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker, supra*; see also *In re Clay, supra* ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem.").

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision always rests upon the Examiner. *In re Mayne, 1 supra*; *In re Deuel, supra*; *In re Bell, supra*; *In re Oetiker, supra*. In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to provide a factual basis to support the obviousness conclusion. *In re Warner, supra*; *In re Lunsford, supra*; *In re Freed, supra*. Appellant respectfully submits that the Examiner has not met this burden with respect to at least independent claim 91.

Thus, the rejection of independent claim 91 must be reversed.

3. Independent claim 126 is not rendered obvious by *Manghirmalani et al.* in view of *Tuli et al.*

Independent claim 126 recites:

"A method of providing feedback to a user during a data input session comprising:

(a) collecting input data from the user using a data interface, said input data comprising:

i) one or more selected data parameters;
ii) weighting information identifying a corresponding weighting factor to be given to each of said one or more selected data parameters; and

(b) providing feedback information to the user while the user is providing said input data, said feedback information being based at least in part on said input data such that the user can

monitor the effect of changing said one or more selected data parameters and/or their associated weighting factors based on relative positioning of each of the selected data parameters by the user.”

The Examiner (Office Action dated August 23, 2006, page 12, line 8) states, “As per claim 126, it is rejected with the same rationale as claim 106. (see rejection above)”

However, Appellant respectfully submits that independent claim 126 recites features not explicitly recited by claim 106. For example, independent claim 126 recites, “ii) weighting information identifying a corresponding weighting factor to be given to each of said one or more selected data parameters; and (b) providing feedback information to the user while the user is providing said input data, said feedback information being based at least in part on said input data such that the user can monitor the effect of changing said one or more selected data parameters and/or their associated weighting factors based on relative positioning of each of the selected data parameters by the user,” which is not explicitly recited by independent claim 106. The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision always rests upon the Examiner. *In re Mayne, supra*; *In re Deuel, supra*; *In re Bell, supra*; *In re Oetiker, supra*. In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to provide a factual basis to support the obviousness conclusion. *In re Warner, supra*; *In re Lunsford, supra*; *In re Freed, supra*. Appellant respectfully submits that the Examiner has not met this burden with respect to at least independent claim 126.

The Examiner now contends that “Manghirmalani teaches providing a user with information regarding network device type of the selected meter type. And this information is feedback information. (see Manghirmalani, col. 12, lines 25-35) And this information is a helpful feedback for users to determine health status of a network.” (Examiner's Answer mailed January 10, 2008, p. 23, ll. 2-5)

Appellant asserts that the reasoning that the Examiner puts forth for the rejection with respect to claim 126 continues to contravene 35 U.S.C. § 132, which requires the Director to “notify the applicant thereof, stating the reasons for such rejection.” This section is violated if the rejection “is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.” *Chester v. Miller, supra*. This policy is captured in the Manual of Patent Examining Procedure. For example, MPEP § 706 states that “[t]he goal of

examination is to clearly articulate any rejection early in the prosecution process so that applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity.” Furthermore, MPEP § 706.02(j) indicates that: “[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.”

Furthermore, the Administrative Procedures Act (APA) mandates the Patent Office to make the necessary findings and provide an administrative record showing the evidence on which the findings are based, accompanied by the reasoning in reaching its conclusions. See *In re Zurko, supra*; *In re Gartside, supra*. The Examiner has failed to provide any findings with regard to the rejection of independent claim 126. Moreover, Appellant respectfully submits that the features recited by claim 126 are neither disclosed nor suggested by any of the cited references, neither alone nor in any reasonable combination, and thus, the rejection of claim 126 must be reversed.

4. Independent claim 131 is not rendered obvious by *Manghirmalani et al.* in view of *Tuli et al.*

Independent claim 131 recites:

“A method of evaluating data records associated with an action and/or transaction, the method comprising:
(a) storing one or more data records, each of said data records including:
i) a set of data parameters identified by a user as pertaining to the action and/or transaction;
ii) a weighting factor to be given to each data parameters in said set of data parameters based on a relative positioning of each of the data parameters by the user;
(b) processing a query by the user, said query requesting an evaluation of a frequency of usage for a data parameter, and/or an evaluation of a rating given to a weighting factor associated with said data parameter, across said data records or a subset thereof;
and
(c) providing feedback to the user in response to said query.”

The Examiner (Office Action dated August 23, 2006, page 13, line 3) states, “As per claim 131, it is rejected with the same rationale as claim 106. (see rejection above)”

However, Appellant respectfully submits that independent claim 131 recites features not explicitly recited by claim 106. For example, independent claim 131 recites, “(ii) a weighting factor to be given to each data parameters in said set of data parameters based on a relative positioning of each of the data parameters by the user; (b) processing a query by the user, said query requesting an evaluation of a frequency of usage for a data parameter, and/or an evaluation of a rating given to a weighting factor associated with said data parameter, across said data records or a subset thereof; and (c) providing feedback to the user in response to said query,” which is not explicitly recited by independent claim 106. The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision always rests upon the Examiner. *In re Mayne, supra*; *In re Deuel, supra*; *In re Bell, supra*; *In re Oetiker, supra*. In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to provide a factual basis to support the obviousness conclusion. *In re Warner, supra*; *In re Lunsford, supra*; *In re Freed, supra*. Appellant respectfully submits that the Examiner has not met this burden with respect to at least independent claim 131.

The Examiner now contends that “Manghirmalani teaches providing a user with information regarding network device type of the selected meter type. And this information is feedback information. (see Manghirmalani, col. 12, lines 25-35) And this information is a helpful feedback for users to determine health status of a network.” (Examiner's Answer mailed January 10, 2008, p. 23, ll. 2-5)

Appellant asserts that the reasoning that the Examiner puts forth for the rejection with respect to claim 131 continues to contravene 35 U.S.C. § 132, which requires the Director to “notify the applicant thereof, stating the reasons for such rejection.” This section is violated if the rejection “is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.” *Chester v. Miller, supra*. This policy is captured in the Manual of Patent Examining Procedure. For example, MPEP § 706 states that “[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity.” Furthermore, MPEP § 706.02(j) indicates that: “[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.”

Furthermore, the Administrative Procedures Act (APA) mandates the Patent Office to make the necessary findings and provide an administrative record showing the evidence on which the findings are based, accompanied by the reasoning in reaching its conclusions. See *In re Zurko, supra*; *In re Gartside, supra*. The Examiner has failed to provide any findings with regard to the rejection of independent claim 131. Moreover, Appellant respectfully submits that the features recited by claim 131 are neither disclosed nor suggested by any of the cited references, neither alone nor in any reasonable combination, and thus, the rejection of claim 131 must be reversed.

Appellant respectfully submits that the Appeal Brief filed July 26, 2007, coupled with the supplemental arguments provided herein in response to the Examiner's Answer mailed January 10, 2008, clearly show that none of the cited references, neither alone nor in and reasonable combination with any other of the cited references, disclose or suggest the features recited by any pending claims as discussed previously. Thus, the rejection of all pending claims should be reversed.

REPLY BRIEF

Serial Number: 09/945,099

Filing Date: August 31, 2001

Title: Interface and Method Adapted for Capturing Subjective Preferences of Program Users

Page 21

Dkt: 0006-003004

VIII. CONCLUSION AND PRAYER FOR RELIEF


For the foregoing reasons, Appellant requests the Honorable Board to reverse each of the Examiner's rejections.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-3521.

Respectfully submitted,

Brake Hughes Bellermann LLP
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Date March 10, 2008


By _____
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